

REMARKS

Claims 3-5, 7-13, 21-24 and 26 are pending in this application. The Applicants acknowledge the withdrawal by the Examiner of the rejection of claims 3, 5, 7 and 10-13 under 35 U.S.C. §102(b) in view of the Applicants' arguments presented in their response submitted May 18, 2007.

Rejection of claims 3-5, 7-13, 21-24 under 35 U.S.C. §112

The rejection is stated as follows:

Claims 3-5, 7-13, 21- 14 [sic] (Applicants assume that the Examiner intended claim 24 and not claim 14 as stated) and 26 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicants in the claims recite the phrase "derivatives". Webster's Dictionary defines a derivative as "a substance derived from, or of such composition and properties, that it may be considered as derived from, another substance by chemical change, esp. By the substitution of one or more elements or radicals". Based on this definition it is unclear what the derivative is.

This rejection is respectfully traversed. "The purpose of the definiteness requirement is so that the public may determine the boundaries of the claimed invention." *United Carbon Co. v. Binney Co.*, 317 US 228 (1942). "The definiteness of the language employed must be analyzed-not in a vacuum, but always in light of the teachings of the prior art and of the particular application disclosure as it would be interpreted by one possessing the ordinary level of skill in the pertinent art." *In re Moore and Janoski*, 169 USPQ 236 (CCPA 1971). It first must be appreciated that the term "derivative" does not stand alone. The terms employed in the present application actually are "cholesterol derivatives" and "oil-soluble cellulose derivatives".

The U.S. Patent and Trademark Office has issued numerous patents which use the term "cholesterol derivatives". As just a few examples, mention may be made of U.S. Patent No. 5,885,948 (see col. 10, line 16, and claims 4, 6); U.S. Patent No. 6,033,680 (see col. 6, lines 27, 28, col. 7, line 3, and claim 4); U.S. Patent No. 6,080,707 (see col. 12, line 5, 20, and claims 4 and 7).

In fact, the meaning of “cholesterol derivatives” must also be clear to the Examiner. In the office action of January 12, 2007, the Examiner rejected the claims as anticipated by Wivell et al. (US 5,599,549). The rejection stated in relevant part:

Wivell et al. teaches a personal cleansing composition comprising an oil phase wherein the oil phase can comprise cholesterol, cholesterol derivatives...(col. 4, lines 48-56).

The patent, at col. 5, lines 27-30, defines cholesterol derivatives as follows: “Examples of cholesterol and cholesterol derivatives include cholesterol, and cholesterol esters and ethers (e.g. cholesterol stearte [*sic*], cholesterol isostearate [*sic*], cholesterol acetate and the like).”

Moreover, the present application provides an example of a preferred cholesterol derivative, “lanosterol” at page 3, lines 16, 17, in Example 1, and in claim 8.

It is the Applicants’ position that those of ordinary skill in the art would be suitably guided by the disclosure in the present application in selecting appropriate derivatives of cholesterol so as to make and use the claimed invention.

Turning now to the term “oil soluble derivatives of cellulose”, it is clear, for example, from a reading of U.S. Patent No. 5,891,450 (see cols. 1, 2) and U.S. Patent No. 4,536,405 (see cols. 1, 4, 5 and claim 5) that cellulose derivatives have been typically used in cosmetics. However, from U.S. Patent No. 4,536,405, it may also be appreciated that these cellulose derivatives have generally been water soluble rather than oil soluble (see col. 1, lines 25-47 and the references, in particular, to “organosoluble cellulose derivatives”). Nevertheless, the patent discloses that an oil soluble cellulose derivative, ethyl cellulose, had been known for use in lip rouge, and further describes additional cellulose derivatives which are both water and oil soluble (see cols. 4-6). Furthermore, the term “oil soluble derivatives of cellulose” is discussed in many other patents issued by the U.S. Patent and Trademark Office. As examples, mention may be made of U.S. Patent No. 2,197,768 (see page 12, right hand column, lines 17, 18); U.S. Patent No. 4,740,571 (see col. 6, lines 15-18) and U.S. Patent No. 5,114,577 (see col. 6, lines 11-13).

Moreover, the present specification, at page 3, line 19 provides a preferred example of an oil soluble cellulose derivative, i.e. ethyl cellulose, for the claimed purposes. Clearly, the present application would provide sufficient guidance to those having ordinary skill in the art in selecting appropriate oil soluble cellulose derivatives for the successful operation of the present invention.

CONCLUSION

In light of the arguments presented above, the rejection under 35 U.S.C. §112, second paragraph, should be withdrawn, as it is unfounded. One of ordinary skill in the art, armed with the knowledge of the prior art, would find sufficient guidance in the present application to select appropriate cholesterol derivatives and oil soluble cellulose derivatives to make and use the claimed invention. It is believed that the claims are in condition for allowance, and a Notice of Allowance is respectfully solicited.

Respectfully submitted,

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